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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,453	10/28/1999	SATORU MOTOHASHI	35.C.13980	4676

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NEW YORK, NY 10112

EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 05/14/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/428,453

Applicant(s)

MOTOHASHI ET AL.

Examiner

Christopher D RoDee

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15,22,26,27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15,22,26,27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 April 2003 requesting entry of the amendment filed 10 March 2003 (received 20 March 2003) has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15, 22, 26, 27, and 29-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recent amendment to each of the independent claims specifying that the second polycarbonate resin has a viscosity average molecular weight of 20,000 or more does not have basis in the specification as filed. The specification as filed only discloses a viscosity average molecular weight of 20,000 for the second polycarbonate.

In one specification embodiment, polycarbonate I has a viscosity-average molecular weight of 5000 and polycarbonate II (corresponding to the second polycarbonate of the claims) has a viscosity average molecular weight of 20,000 (p. 12, l. 1-10). In another embodiment 30 to 95 parts by weight of polycarbonate I having a viscosity average molecular weight of 15,000 or less is combined with a polycarbonate II with unspecified properties (p. 13, l. 17-22). These are the only possible areas for support for the currently claim language, yet they do not provide the requisite description.

There is no specification disclosure of the second polycarbonate resin having the claimed range of viscosity average molecular weight in the charge transport layer. The claims contain new matter. Because all claims include the limitations of the independent claims, the rejection is applicable to all claims under consideration.

✓ The specification as filed also fails to disclose a process unit as claimed in claim 31 (and claim 32 by its dependence) having only the photosensitive member and the cleaning blade. The specification discloses a process cartridge having the means specified on specification page 27, lines 2-12. This includes a photosensitive drum, a cleaning blade, a charge roller, and a developing means. The specification also discloses that a process cartridge having the photosensitive member and at least one of the means disclosed on page 8, line 19 - page 9, line 3 can be used in the instant invention. These means include a latent image forming means, a developing means, and a transfer means, but a cleaning means is not disclosed for this embodiment. Figure 4 depicts a device for testing the photosensitive member that comprises the photosensitive drum, a charging roller, and a cleaning blade (spec. p. 15, l. 1-21). The embodiment of Figure 4 is represented by pending claim 15.

Art Unit: 1756

There is no basis in the specification for the process unit as claimed in claims 31 and 32 noting the above passages and those cited by applicants in the recent response.

✓ Further consideration also requires a rejection of claim 27 under this section and paragraph because there is no disclosure of a process unit detachably mountable to a main body of an image forming apparatus having only the claimed photosensitive member, charging member, and cleaning member. The specification discloses a process cartridge having a photosensitive drum, a cleaning blade, a charge roller, and a developing means (spec. p. 27, l. 2-12). The process cartridge is detachably mountable to the apparatus (spec. p. 9, l. 7-8) however the device of Figure 4 (which appears to be the embodiment of the instant claim) is not a process cartridge as disclosed by the specification because it does not contain the required components of the process cartridge. For example, there is no developing means in the process cartridge of the claim. The specification does not disclose a process unit as claimed as being detachably mountable to the apparatus.

See p. 12+
Claim 30 is also rejected under this section and paragraph because there is no disclosure of using an AC voltage on the charging member (note typographical error in the claim) of the unit of this claim. Although application of an AC voltage is disclosed for certain embodiments (see spec. p. 26, l. 12-21) there is no disclosure of such a voltage for the device of claim 30 dependent on claim 15.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The art cited in this Office action discloses apparatuses and/or devices with one or

Art Unit: 1756

a mixture of polycarbonates in the charge transport layer. Of these references, Kemmesat *et al.* in US Patent 6,001,523 is particularly relevant because Example 8 discloses a charge transport layer with a combination of polycarbonates with PTFE particles. These charge transport layers are used to prepare imaging members of an electrophotographic copying machine. The Examiner is unable to find any evidence indicating the viscosity-average molecular weights of the polycarbonates of this example are within the scope of the claims. However, if applicants are aware of any pertinent evidence concerning these resins they are asked to bring this information to the Examiner's attention. The reference does not explicitly disclose the claimed scraped particles characteristics of the instant claims.

US Patent 6,169,869 is unavailable as prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

cdr
May 9, 2003


CHRISTOPHER RODEE
PRIMARY EXAMINER